#47
Part of Paper # 4
09/177,502
Attorney Docket No. 6530.8050

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

CHARLES R. SLATER, Junior Party, v. MARK A. RYDELL, Senior Party.	)	INTERFERENCE NO. 103,765 Honorable William F. Pate, III Administrative Patent Judge

BOX INTERFERENCE
Honorable Commissioner of
Patents and Trademarks
Washington, DC 20231

FILED VIA HAND DELIVERY
TO THE BOARD

Sir:

SLATER'S REPLY TO RYDELL'S OPPOSITION
TO RULE 615 REQUEST FOR CONSENT TO AMEND
APPLICATION AND FILE RULE 53(b) DIVISIONAL APPLICATION

Junior Party Slater has requested the Administrative Patent Judge's consent to amend its application in interference by canceling claims 24-29 that do not correspond to count 2, the only count in the interference, and to file a divisional application to prosecute those claims. Claims 24-29 are directed to an endoscopic scissor blade, whereas count 2 is directed to a bipolar electrosurgical instrument. The parties agree that the blade claims define a separately patentable invention from the count. However, Senior Party Rydell has opposed Slater's request to separately prosecute claims to the separately patentable blade invention.

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ARGUMENT

I. Delay Will Shorten the Patent Term

Delaying ex parte prosecution of claims 24-29 will significantly diminish the patent term available to Slater for these claims. The term of a patent issuing with blade claims will be 20 years from Slater's original filing date of December 13, 1994. Delaying prosecution until after final resolution of this interference will cause a meaningful loss of patent term. Indeed, the divisional application apparently will not even be entitled to an extension based on the involvement of its parent case in this interference.[1]

This interference is in its early stages--the testimony period is just beginning. Currently, the testimony period closes in December 1998, and briefing ends in March 1999. Final resolution of the case may be over a year away. Each day that passes until then is one less day of term available to Slater.[2]

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[1] It appears the patent term may not be extended under 35 U.S.C. § 154(b) and 37 C.F.R. § 1.701. According to PTO policy, these extension provisions are only applicable to applications filed on or after June 8, 1995. Additionally, interferences involving applications filed prior to that date apparently cannot serve as a basis for an extension for a continuation application of the involved application that is filed after June 8, 1995. *See* Questions and Answers Regarding the Gatt Uruguay Roundtable and NAFTA Changes to U.S. Patent Law and Practice (Ex. A) at p. 12, Question 28.

[2] Rydell asserts that "[e]vidence will necessarily come out in the interference as to what the parties actually made and that will constitute additional prior art under 35 U.S.C. § 102(g)." *See* Opposition at 2, f.n.1. What the evidence will be in this interference and whether it will constitute prior art are pure speculation. To this point, for example, Rydell has submitted no evidence of a reduction to practice prior to its filing date, a date which Slater has already antedated with evidence.

In addition, because the PTO has not examined the blade claims, prosecution of an application directed to the blade claims likely will take sometime. During prosecution, any

(continued...)

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II. The First Inventor of the Count Is Not Necessarily the First Inventor of the Different Blade Invention

Rydell submits only one argument against Slater's request for consent to cancel claims 24-29 and file a divisional application to prosecute those claims. Rydell argues that at least some of claims 24-29 can be patentable to Slater only if it proves priority as to count 2. Rydell states that "[t]he party that first invented the 'bipolar electrosurgical instrument' of Count II necessarily was the first to invent the subject matter of claims 24, 25 and 29 in that the 'at least one blade member' of Count II conforms one-for-one with the 'endoscopic scissors blade' as defined in claims 24, 25 and 29 in the Slater application." (Emphasis added.) Thus, argues Rydell, prosecution of claims 24-29 in parallel with this interference could result in a patent having claims which are invalid under 35 U.S.C. § 102(g).[3]

The parties agree that the subject matter of claims 24-29, an endoscopic scissor blade, is separately patentable from the subject matter of the interference, a bipolar electrosurgical instrument. Rydell argued such when it moved to add a count corresponding to a scissor blade. *See* Rydell's Preliminary Motion Under 37 C.F.R. § 1.633(c)(1) To Redefine the Interfering Subject Matter by Adding a Count (Paper No. 16) at 10-13. Rydell stated that the scissor blade invention "is directed only to a blade with a

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[2](...continued)
relevant evidence introduced in the interference will be available for the Examiner's consideration.

[3] Rydell provides no reasons why claims 26-28 should not be prosecuted during pendency of this interference.

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particular arrangement of insulating and metal materials . . . and is not limited to a scissors arrangement of two cooperating blade members." *Id.* at 2-3. Citing commentary in the Official Gazette, Rydell further stated that "the standard of patentability is not applied on a mutual basis" to such separate inventions. *Id.* at 12.

The PTO consistently has determined that an endoscopic scissor blade is a separately patentable invention from a bipolar electrosurgical instrument. *See* Redeclaration (Paper No. 32) at 2 and Correction to Redeclaration (Paper No. 34) (both indicating that claims 24-29 do not correspond to count 2); Interference Initial Memorandum mailed October 2, 1996 (Ex. B) at 3 (claims 24-29 not drawn to count, as setting forth merely a blade with a particular arrangement of materials that may be interpreted to include any blade structure); Office Action of June 2, 1994 in Rydell involved application (Ex. C) at 2 (requiring restriction of blade invention from electrosurgical instrument invention because the instrument can use other blades and the blade has separate utility in, for example, a different tool).

Separately patentable inventions, by their very definition, have different standards of patentability, and may have differing dates of invention and evidence relating thereto. Rydell's proposition that the party that first invented the bipolar electrosurgical instrument necessarily first invented the blade is simply inconsistent with the separate patentability determination. Similarly, Rydell's suggestion that prosecution of claims 24-29 in parallel with this interference could result in invalid claims is unsubstantiated. The Examiner assigned to the Slater application can consider the interference record during examination.

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For these reasons, and the reasons submitted in Slater's Request For Consent to Amend Application and File Divisional Application, ex parte prosecution of claims 24-29 is appropriate.

Respectfully submitted,

Dated: July 10, 1998

By: 

Albert J. Santorelli, Reg. No. 22,610
Barbara C. McCurdy, Reg. No. 32,120
Leslie I. Bookoff, Reg. No. 38,084
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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing SLATER'S REPLY TO RYDELL'S OPPOSITION TO RULE 615 REQUEST FOR CONSENT TO AMEND APPLICATION AND FILE RULE 53(b) DIVISIONAL APPLICATION was served on the party Rydell, through its attorneys of record, on this 10th day of July, 1998 as follows:

By Federal Express:

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By: Virginia McNelis
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Pap No 43

Part of Paper #4

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Before the Board of Patent Appeals and Interferences

Slater	)	
	)	
v.	)	INTERFERENCE NO. 103,765
	)	
Rydell	)	Administrative Patent Judge Pate

OPPOSITION TO JUNIOR PARTY'S RULE 615 REQUEST FOR CONSENT TO AMEND APPLICATION AND FILE RULE 53(b) DIVISIONAL APPLICATION

The Junior Party has requested leave to file a divisional application during the pendency of the present interference to pursue so-called "blade claims", i.e., claims 24-29 of the Slater application, Serial No. 08/354,992, filed December 13, 1994, which claims were impliedly determined by the Administrative Patent Judge not to correspond to Count II of the present interference.

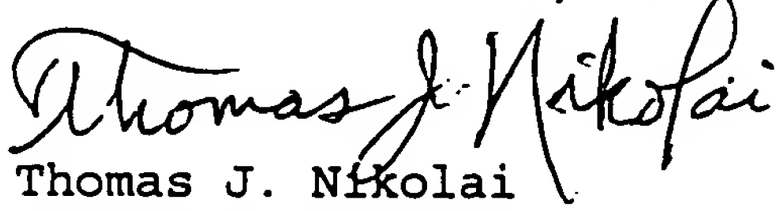
The Senior Party submits that the request should be denied in that at least claims 24, 25 and 29 can only be patentable to the Junior Party if it can prove priority over the Senior Party as to Count II of the interference. The party that first invented the "bipolar electrosurgical instrument" of Count II necessarily was the first to invent the subject matter of claims 24, 25 and 29 in that the "at least one blade member" of Count II conforms one-for-one with the "endoscopic scissors blade" as defined in claims 24, 25 and 29 in the Slater application. To permit the Junior Party to proceed with an effort to secure the

"blade claims" in parallel with the present interference could result in a patent being granted to Slater having claims that were invented in this country by another (Rydell) who had not abandoned, suppressed or concealed and which are, therefore, invalid under 35 U.S.C. §102(g).

While it may turn out that the "blade claims" are patentable to the Junior Party, this can only be determined after priority is awarded to it in the present interference[1]. For the reasons advanced, prosecution of the "blade claims" in a separate divisional application should be deferred until the outcome of the present interference is resolved.

Respectfully submitted,

HAUGEN AND NIKOLAI, P.A.



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[1]Evidence will necessarily come out in the interference as to what the parties actually made that will constitute additional prior art under 35 U.S.C. §102(g).

CERTIFICATE OF MAILING

I hereby certify that the foregoing OPPOSITION TO JUNIOR PARTY'S RULE 615 REQUEST FOR CONSENT TO AMEND APPLICATION AND FILE RULE 53(b) DIVISIONAL APPLICATION in the above-identified Interference No. 103,765 is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Box Interference, Commissioner of Patents and Trademarks, Washington, D.C. 20231 on June 25, 1998.

Linda J. Rice

Linda J. Rice, Secretary for
Thomas J. Nikolai

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing copy of the OPPOSITION TO JUNIOR PARTY'S RULE 615 REQUEST FOR CONSENT TO AMEND APPLICATION AND FILE RULE 53(b) DIVISIONAL APPLICATION in the above-identified Interference No. 103,765 was served via Federal Express, shipping prepaid, upon Junior Party's Attorney, Barbara C. McCurdy, Esq., Finnegan, Henderson, Farabow, Garrett and Dunner, Suite 700, 1300 I Street N.W., Washington, D.C. 20005-3315 on June 25, 1998.

Linda J. Rice

Linda J. Rice, Secretary for
Thomas J. Nikolai

Pap No 41

Part of Paper #4

Attorney Docket No. 6530.8050

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

CHARLES R. SLATER, Junior Party, v. MARK A. RYDELL, Senior Party.	INTERFERENCE NO. 103,765 Honorable William F. Pate, III Administrative Patent Judge

BOX INTERFERENCE
Honorable Commissioner of
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Washington, DC 20231

**FILED VIA HAND DELIVERY
TO THE BOARD**

Sir:

**RULE 615 REQUEST FOR CONSENT TO AMEND APPLICATION
AND FILE RULE 53(b) DIVISIONAL APPLICATION**

Pursuant to the Decisions on Preliminary Motions and the Redeclaration dated April 10, 1998, this interference has been redeclared substituting count 2 for count 1. The claims of Junior Party Slater corresponding to count 2 are claims 1-23 and 30-39. *See* Redeclaration (Paper No. 32) and Correction to Redeclaration (Paper No. 34); *see also* Original Declaration of Interference (Paper No. 6) at 3. Slater claims 24-29, directed to an endoscopic scissor blade for use in a bipolar endoscopic instrument, did not correspond to original count 1 and do not correspond to substitute count 2. Id.

Pursuant to 37 C.F.R. § 1.615, Junior Party requests consent of the Administrative Patent Judge to amend the application in interference, Serial No. 08/354,992, by canceling

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claims 24-29 that do not correspond to count 2. Junior Party further requests consent of the Administrative Patent Judge to file a divisional application of the application in interference, pursuant to 37 C.F.R. § 1.53(b), to prosecute claims 24-29. Consent should be granted because Slater claims 24-29 do not correspond to the count (i.e., are separately patentable from the subject matter of the interference) and are therefore not at issue in this interference. Ex parte prosecution of these claims is therefore appropriate.

With this Rule 615 Request, and for the convenience of the Administrative Patent Judge, Junior Party has provided two copies of a separate draft Order Granting Consent to Amend Application and File Rule 53(b) Divisional Application.

Respectfully submitted,

Dated: June 9, 1998

By: _____

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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing RULE 615 REQUEST FOR CONSENT TO AMEND APPLICATION AND FILE RULE 53(b) DIVISIONAL APPLICATION was served on the party Rydell, through its attorneys of record, on this 9th day of June, 1998 as follows:

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

CHARLES R. SLATER, Junior Party, v. MARK A. RYDELL, Senior Party.	INTERFERENCE NO. 103,765 Honorable William F. Pate, III Administrative Patent Judge

ORDER GRANTING CONSENT TO AMEND APPLICATION AND FILE RULE 53(b) DIVISIONAL APPLICATION

Consent is hereby granted for Junior Party Slater to: (1) amend the application in interference, Serial No. 08/354,992, by canceling claims 24-29; and (2) file a divisional application of the application in interference, pursuant to 37 C.F.R. § 1.53(b), to prosecute claims 24-29.

Dated:_____, 1998

_____
William F. Pate, III
Administrative Patent Judge

cc: Barbara C. McCurdy, Esq. (Attorney for Junior Party Slater)
Thomas J. Nikolai, Esq. (Attorney for Senior Party Rydell)